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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

Application Number: 09/956,989
Filing Date: September 21, 2001
Appellant(s): PIPONIUS ET AL.

FEB 2 1 2008

Technology Center 2100

Thomas Frame (47,232)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/17/2007 appealing from the Office action

mailed 08/21/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,047,051	GINZBOORG ET AL	04-2000
6,389,537	DAVIS ET AL	05-2002
5,905,736	RONEN ET AL	05-1999
5,956,391	MELEN ET AL	09-1999
5,970,477	RODEN	10-1999
2002/0059114	COCKRILL ET AL	05-2002
5,852,812	REEDER	12-1998
5,778,189	KIMURA ET AL	07-1998
5,319,454	SCHUTTE	06-1994

Printout of the definition of "control" from dictionary.com printed 08/07/2007. 4 pages.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1, 6-8, 11, 13, 16, 19-22, 27 and 28 rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent 6,047,051 by Ginzboorg et al. (Ginzboorg) in

view of U.S. Patent 6,389,537 by Davis et al. (Davis).

With respect to Claim 1, Ginzboorg teaches a method for providing a piece of

content to a subscriber terminal from a content server, wherein the provision of the

content from the content server to the subscriber terminal is controlled by a proxy, and

said control of the content provision comprises the following steps:

- receiving in the proxy a content request for providing the content (Col. 5 lines

43 - Col. 6 line 2),

- determining, by the proxy, whether of not the content is chargeable content,

wherein the determining step includes accessing a database that includes information

that is indicative of which content is chargeable and which content is free to end users

connected to a network (Col. 6 lines 3-8; Col. 12, lines 42-52; Col. 10 line 21-29; and

Col. 13 lines 15-24);

- determining by means of the proxy a billing address for the chargeable content

(Col. 5 lines 56-65 and Col. 7 lines 47-59)

- providing the content corresponding to the content request under the control of

the proxy from the content server to the subscriber terminal (Col. 6 lines 55-63), and

- generating billing information related to the chargeable content (Col. 6 lines 3-

29 and Col. 7 lines 36-59) wherein generating billing information includes accessing a

subscriber terminal profile (Col. 5 line 19-31 and Col. 5 line 43 - Col. 6 line 63).

Ginzboorg does not explicitly disclose the including a prepaid amount provided

by an end user of the subscriber terminal (i.e. the technique of using a prepaid amount

in the charging functionality). Davis teaches the use of a prepaid amount provided by

an end user of a subscriber terminal (Col. 1 lines 24-36). This is a known technique

enabling users to purchase content, such as movies and similar programming, by

applying the charge(s) to the prepaid amount as long as the prepaid balance is not

exhausted (Col. 1 lines 10-12 and 24-36).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method disclosed by Ginzboorg and modify it as

indicated by Davis such that the method further comprises wherein the subscriber

terminal profile includes a prepaid amount provided by an end user of the subscriber

terminal. One would be motivated to have this, as it is a simple and known purchasing

scheme for use in provisioning of content to users (In Davis: Col. 1 lines 10-12 and 24-

36).

Further it would have been obvious to one of ordinary skill in the art at the time

the invention was made to apply the technique of using a prepaid amount as taught by

Davis (Col. 1 lines 10-12 and 24-36), to improve billing and charging elements of

Ginzboorg for the predictable result of enabling content to be purchased by users

through the use of a prepaid balance.

With respect to Claim 6, Ginzboorg further teaches wherein the subscriber

identity of the subscriber terminal is hidden from the content server (In Ginzboorg: Col.

5 line 52 - Col 6 line 2).

With respect to Claim 7, Ginzboorg further teaches wherein the generation of

the billing information related to the content comprises the step of maintaining billing

criteria in a database functionally connected to the proxy (In Ginzboorg: Col. 6 lines 3-

29).

With respect to Claim 8, Ginzboorg further teaches wherein the billing criteria

comprise the payer of the content (In Ginzboorg: Col. 6 lines 3-29 and Fig. 4).

With respect to Claim 11, Ginzboorg further teaches wherein the billing criteria

comprise information on whether the content in question belongs to a group of content

segments with a special price (In Ginzboorg: Col. 12 lines 42-53).

With respect to Claim 13, Ginzboorg further teaches wherein determining the

billing address comprises: allocating an IP address to the subscriber terminal in an

access network (In Ginzboorg: Col. 5 lines 52-62 - Note: The socket address of a TCP

connection would contain the IP address allocated to the subscriber); receiving, in the

proxy, the IP address allocated to the subscriber terminal (In Ginzboorg: Col. 5 lines 52-

62); determining, in the proxy, a subscriber identity based on the IP address and

correlating it to the billing address (In Ginzboorg: Col. 5 lines 52-65 and Col. 7 lines 47-

59).

With respect to Claim 16, Ginzboorg further teaches if the content is part of a

group of content segments, then the subscriber terminal is entitled to use a portion of

the group at a lower price or for free (In Ginzboorg: Col. 13 lines 15-24 and Col. 10 lines

21-29).

With respect to Claim 19, Ginzboorg further teaches wherein generating billing

information further includes billing the subscriber for content delivered by the content

server to the subscriber terminal (In Ginzboorg: Col. 5 line 43 - Col. 6 line 63 describes

the overall process).

With respect to Claim 20, Ginzboorg further teaches the proxy is configured to

identify one or more pieces of content that are included in an agreement between an

operator of the content server and an operator of the proxy (In Ginzboorg: Col. 5 lines 1-

19 and lines 52-64).

With respect to Claim 21, Ginzboorg further teaches the proxy does not forward

the content request to the content server until the proxy identifies whether or not

selected content is included in an agreement between an operator of the content server

and an operator of the proxy (In Ginzboorg: Col. 5 lines 1-19 and lines 52-64 and Col. 6

lines 55-63).

With respect to Claim 22, Ginzboorg further teaches wherein the proxy directly

forwards the content request to the content server after until the proxy identifies that

selected content is not included in an agreement between an operator of the content

server and an operator of the proxy (In Ginzboorg: Col. 5 lines 1-19 and lines 52-64

and Col. 6 lines 55-63).

With respect to Claim 27, Ginzboorg further teaches wherein the content is not

billed at one time because it corresponds to streaming content (In Ginzboorg: Col. 10

lines 26-29).

With respect to Claim 28, Ginzboorg further teaches wherein a price for the

content is determined based on a time at which the content is requested (In Ginzboorg:

Col. 12 lines 42-51).

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ginzboorg in view of Davis and U.S. Patent 5,905,736 by Ronen et al. (Ronen).

With respect to Claim 2, Ginzboorg in view of Davis teaches all the limitations

of Claim 1, and further teaches the subscriber terminal is located in an access network

in which the subscriber terminal is addressed by an access network subscriber identity

(Col. 4 lines 43-51), and the content server is located in a service network in which it is

addressed by an IP address (In Ginzboorg: Col. 4 lines 37-42), and wherein the

determination of the billing address comprises the following steps: allocating an IP

address to the subscriber terminal in an access network (In Ginzboorg: Col. 5 lines 52-

62 - Note: The socket address of a TCP connection would contain the IP address

allocated to the subscriber); receiving, in the proxy, the IP address allocated to the

subscriber terminal (In Ginzboorg: Col. 5 lines 52-62); determining, in the proxy, a

subscriber identity based on the IP address and correlating it to the billing address (In Ginzboorg: Col. 5 lines 52-65 and Col. 7 lines 47-59).

Ginzboorg in view of Davis does not explicitly teach the determined subscriber identity is the access network subscriber identity. Ronen teaches the determination of a subscriber identity that is an access network subscriber identity based on an IP address allocated to the subscriber identity and using it to determine the billing address (In Ronen: Col. 2 lines 31-46 and Col. 6 lines 30-51 - essentially the correlation of the ANI with the IP address can be used to determine the billing). The use of the access network subscriber identity allows for a casual user to make use of the billing system without an explicit pre-configuration/registration with the billing system (In Ronen: Col. 2 lines 31-46 and Col. 6 lines 30-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Ginzboorg in view of Davis and modify it as indicated by Ronen such that the method further comprises allocating an IP address to the subscriber identity in the access network or at its edge; receiving, in the proxy, the IP address allocated to the subscriber identity; determining in the proxy on the basis of the received IP address the subscriber identity of the subscriber terminal and using it to determine the billing address. One would be motivated to have this, as there is need for providing a convenient method for billing of services through different providers, particularly for those using the services on a casual or infrequent basis (In Ronen: Col. 1 lines 21-38, Col. 1 line 65 - Col. 2 line 2, and Col. 2 liens 31-46).

With respect to Claim 3, Ginzboorg further teaches wherein the determination

of the subscriber identity on the basis of the received IP address comprises an inquiry to

a database in the proxy (In Ginzboorg: Col. 5 line 52 - Col 6 line 2) *and* (In Ronen: Col.

2 lines 31-46 and Col. 6 lines 30-51).

With respect to Claim 4, Ginzboorg further teaches wherein the determination

of the subscriber identity on the basis of the received IP address comprises an inquiry to

the access network (In Ginzboorg: Col. 5 line 52 - Col 6 line 2) *and* (In Ronen: Col. 2

lines 31-46 and Col. 6 lines 30-51).

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ginzboorg in view of Davis and U.S. Patent 5,956,391 by Melen et al. (Melen).**

With respect to Claim 5, Ginzboorg teaches all the limitations of Claim 1 and

further teaches the forming of bills by using known methods (In Ginzboorg: Col. 7 lines

50-59).

Ginzboorg in view of Davis does not explicitly disclose wherein the billing

information related to the content service is sent to the access network to be combined

with the billing information of the access network. Melen teaches a method where

billing information related to content services is sent to the access network to be

combined with the billing information of the access network (Col. 3 line 63 - Col. 4 line

10, and Col. 8 line 50 - Col. 9 line 7).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method disclosed by Ginzboorg in view of Davis and

modify it as indicated by Melen such that the method further comprises wherein said

billing information related to the content is sent to the access network to be combined

with billing information of the access network. One would be motivated to have this as it

improves the reliability of ordering content services (Col. 3 lines 50-60 of Melen).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ginzboorg in view of Davis and U.S. Patent 5,970,477 by Roden (Roden).

With respect to Claim 9, Ginzboorg in view of Davis teaches all the limitations

of Claim 1. Ginzboorg in view of Davis does not explicitly disclose that when a content

service provider pays for the content service, the provider can also pay for

telecommunication costs between the subscriber terminal and proxy. Roden teaches

that when a when a content provider pays for the content, the provider can also pay for

telecommunication costs between the subscriber terminal and proxy such that the use

of the content is free of charge to the subscriber (Col. 7 lines 9-17, Col. 8 lines 43-57

and Col. 9 lines 7-25).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method disclosed by Ginzboorg in view of Davis and

modify it as indicated by Roden such that the method further comprises wherein if the

content provider pays for the content, the content provider pays for telecommunications

costs between the subscriber terminal and the proxy, in which case the use of the

content is completely free of charge to the subscriber. One would be motivated to have

this as there is need for flexible methods for allocating costs associated with Internet

access (Col. 4 lines 32-40 of Roden).

Claims 10, 14 and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ginzboorg in view of Davis and U.S. Patent Application

Publication 2002/0059114 by Cockrill et al (Cockrill).

With respect to Claim 10, Ginzboorg in view of Davis teaches all the limitations

of Claim 1 but does not explicitly disclose information on whether the subscriber has

been billed for the same content, in which case the following uses of the same content

will be billed according to a lower tariff or not at all. Cockrill teaches information to

determine whether the subscriber has been billed for the same content, in which case

the following uses of the same content will be billed according to a lower tariff or not at

all (Page 7 [0071], particularly step 807).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method of Ginzboorg in view of Davis and modify it as

indicated by Cockrill such that the method further comprises wherein the billing criteria

comprise information on whether the subscriber in question has already been billed for

the same content, in which case the following uses of the same content will be billed

according to a lower tariff or not at all. One would be motivated to have this as it

facilitates the purchase of content and management of purchased content (Page 2

[0015] and [0016] of Cockrill).

With respect to Claim 14, Ginzboorg in view of Davis teaches all the limitations of Claim 1 but does not explicitly disclose billing information is generated based on billing criteria that includes whether or not the subscriber terminal has previously been billed for the same content. Cockrill teaches information to determine whether the subscriber has been billed for the same content, in which case the following uses of the same content will be billed accordingly (Page 7 [0071], particularly step 807).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method of Ginzboorg in view of Davis and modify it as indicated by Cockrill such that the method further comprises wherein the billing information is generated based on billing criteria that includes whether or not the subscriber terminal has previously been billed for the same content. One would be motivated to have this as it facilitates the purchase of content and management of purchased content (Page 2 [0015] and [0016] of Cockrill).

With respect to Claim 15, Ginzboor teaches all the limitations of Claim 1 but does not explicitly disclose billing information is generated based on billing criteria that includes whether or not the content is a part of a group of content segments that are offered at a special price. Cockrill teaches information to determine whether the subscriber has been billed for the same content, in which case the following uses of the same content will be offered according to a special price (Page 7 [0071], particularly step 807).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method of Ginzboorg in view of Davis and modify it as

indicated by Cockrill such that the method further comprises wherein the billing

information is generated based on billing criteria that includes whether or not the

content is a part of a group of content segments that are offered at a special price. One

would be motivated to have this as it facilitates the purchase of content and

management of purchased content (Page 2 [0015] and [0016] of Cockrill).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ginzboorg in view of Davis and U.S. Patent 5,852,812 by Reeder (Reeder).

With respect to Claim 17, Ginzboorg in view of Davis teaches all the limitations

of Claim 1 but does not explicitly disclose performing, by the proxy, one or more

currency conversions in cases where currencies used in an access network, to which

the subscriber terminal is part of, and a service network, which can couple the proxy

and the content server, are different. Reeder teaches that currencies in one network

can be different than currencies in another network from which content is being

provided (Col. 6 lines 55-65). To remedy this, Reeder teaches the use of currency

conversion for a billing system in such a situation (Col. 6 lines 55-65 and Col. 3 lines 16-

25).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method disclosed by Ginzboorg in view of Davis and

modify it as indicated by Reeder such that the method further comprises performing, by

the proxy, one or more currency conversions in cases where currencies used in an

access network, to which the subscriber terminal is part of, and a service network,

which can couple the proxy and the content server, are different. One would be

motivated to have this, as there is need for addressing currency conversion in computer

systems involved in networks with different associated currencies (In Reeder: Col. 1

lines 45-57 and Col. 6 lines 55-65).

Claims 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ginzboorg in view of Davis and U.S. Patent 5,778,189 by Kimura et a. (Kimura).

With respect to Claim 18, Ginzboorg in view of Davis teaches all the limitations

of Claim 1 but does not explicitly disclose performing, by the proxy, one or more

protocol conversions in cases where protocols used in an access network, to which the

subscriber terminal is part of, and a service network, which can couple the proxy and

the content server, are different. Kimura teaches that protocols in one network can be

different than protocols in another network from which content is being provided (Col. 2

lines 45-53). To remedy this, Kimura teaches the use of protocol conversion for a

communication system to allow for proper communications between networks in such a

situation (Col. 2 lines 45-53).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method disclosed by Ginzboorg in view of Davis and

modify it as indicated by Kimura such that the method further comprises performing, by

the proxy, one or more protocol conversions in cases where protocols used in an

access network, to which the subscriber terminal is part of, and a service network,

which can couple the proxy and the content server, are different. One would be

motivated to have this, as there is need for being able to communicate between nodes

located in disparate networks (In Kimura: (Col. 1 lines 12-19 and Col. 2 lines 45-53).

**Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Ginzboorg in view of Davis and U.S. Patent 5,319,454 by Schutte (Schutte).**

With respect to Claim 24, Ginzboorg in view of Davis teaches all the limitations

of Claim 23 but does not explicitly disclose including a maximum amount for unbilled

content that is reflected by an agreement between an end user of the subscriber

terminal and an operator of the content server or an operator of the proxy. Schutte

teaches a maximum amount for unbilled content to limit the obligation of the subscriber

in terms of billing (Col. 6 lines 30-34).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to take the method disclosed by Ginzboorg in view of Davis and

modify it as indicated by Schutte such that the method further comprises wherein the

subscriber terminal profile including a maximum amount for unbilled content that is

reflected by an agreement between an end user of the subscriber terminal and an

operator of the content server or an operator of the proxy. One would be motivated to

have this, as it is desirable to have a maximum amount for unbilled content (In Schutte:

Col. 6 lines 30-34).

With respect to Claim 25, Ginzboorg in view of Davis and Schutte teaches all

the limitations of Claim 24 and further teaches wherein the proxy does not fulfill content

requests if the maximum amount for unbilled content has been reached (In Schutte:

Col. 6 lines 30-34).

Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Ginzboorg in view of Ronen.

With respect to Claim 29, Ginzboorg teaches a proxy system for providing

content service, the apparatus comprising;

a router component in communication with a subscriber terminal through an

access network, the router component operable to receive a request for content service

from the subscriber terminal and to determine if the content service is chargeable (In

Ginzboorg: Col. 6 lines 3-8; Col. 12, lines 42-52; Col. 10 line 21-29; and Col. 13 lines

15-24);

a web switch component operable to receive the request from the router

component and to deliver the content service to the subscriber terminal if the content

service is chargeable(In Ginzboorg: Col. 6 lines 55-63); and

a processor component comprising control logic operable to determine a billing

address for the subscriber terminal based on a subscriber identity that uniquely

identifies the subscriber terminal (In Ginzboorg: Col. 5 lines 52-65 and Col. 7 lines 47-

59), to monitor the delivery of the content service to the subscriber terminal (In

Ginzboorg: Col. 7 lines 36-49), and to generate billing information based on the delivery

of the content service (In Ginzboorg: Col. 7 lines 36-59).

Ginzboorg does not explicitly disclose the subscriber identity uniquely identifies the subscriber terminal to the access network. Ronen teaches the determination of a subscriber identity, that uniquely identifies the subscriber terminal to the access network, based on an IP address allocated to the subscriber identity and using it to determine the billing address (In Ronen: Col. 2 lines 31-46 and Col. 6 lines 30-51 - essentially the correlation of the ANI with the IP address can be used to determine the billing). The use of the access network subscriber identity allows for a casual user to make use of the billing system without an explicit pre-configuration/registration with the billing system (In Ronen: Col. 2 lines 31-46 and Col. 6 lines 30-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Ginzboorg in view of Davis and modify it as indicated by Ronen such that the proxy system further comprises a processor component comprising control logic operable to determine a billing address for the subscriber terminal based on a subscriber identity that uniquely identifies the subscriber terminal to the access network, to monitor the delivery of the content service to the subscriber terminal, and to generate billing information based on the delivery of the content service. One would be motivated to have this, as there is need for providing a convenient method for billing of services through different providers, particularly for those using the services on a casual or infrequent basis (In Ronen: Col. 1 lines 21-38, Col. 1 line 65 - Col. 2 line 2, and Col. 2 liens 31-46).

With respect to Claim 30, Ginzboorg further teaches wherein the processor component further comprises control logic operable to transmit the billing information to

a billing system associated with the access network (In Ginzboorg: Col. 4 lines 14-18

and Col. 7 lines 36-59).

With respect to Claim 31, Ginzboorg further teaches wherein the processor

component determines the billing address by matching the subscriber identity to a

network address from the subscriber terminal (In Ronen: Col. 2 lines 31-46 and Col. 6

lines 30-51).

(10) Response to Argument

Argument 1

Appellant argues on page 10 of the appeal brief (under claim 1),

"*Ginzboorg is problematic for a number of tangible reasons. For example,*
Independent Claim 1 recites an architecture in which the provision of the content
from the content server to the subscriber terminal is controlled by a proxy. The
proxy controls the information flow from the Content Server to the subscriber
terminal. Nothing in Ginzboorg accounts for this control and this control is
circumscribed by Independent Claim 1. Ginzboorg, instead, offers a billing server
that authenticates or authorizes content: not control its delivery."

Examiner's response to Argument 1:

Appellant's argument focuses on the claim language "*providing content*

corresponding to the content request under the control of the proxy from the

content server to the subscriber terminal". It seems appellant is implying a very

narrow scope for the language "*under the control of the proxy*". Claim 1 does not

provide any specific limitations regarding the specific form of the control.

Ginzboorg states, "the billing server asks the service provider to start sending the information to the customer." (Col. 6 lines 55-63). The examiner considers such a teaching to be within the scope of content delivery "under the control of a proxy" as clearly the proxy is in control of when the content is being delivered through the action of asking the service provider to start sending the content.

Particularly, it is noted that Col. 6, lines 55-63, describes the billing server (proxy) as asking the service provider to deliver the content only after the billing server has authenticated the charging record. In other words, the content is not delivered unless the billing server verifies the record and tells the service provider to provide the content once verification is affirmed. Clearly this is a form of control as such functionality shows the billing server has the authority and ability to manage and direct the delivery of requested content being provided from a content server to the subscriber. Such interpretation is based on "control" being defined as the act or power of regulation, the authority or ability to manage or direct, and/or the power to direct or determine (see the dictionary.com printout citing various dictionary sources). As such, the examiner asserts the teachings of Ginzboorg are within the scope of the claimed limitation *"providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal"*.

Argument 2

Appellant argues on pages 10-12 of the appeal brief (under Claim 1),

> "*A fundamental difference between Ginzboorg and the pending subject matter is that a request for content is received by the proxy before content is retrieved from a content server. This is disparate from the teachings of Ginzboorg. This order of operation is critical for billing by the proxy...The timing of these billing operations is important for several reasons...*"

Examiner's response to Argument 2:

The examiner first notes that appellant has not indicated the specific claim language at issue. Particularly, appellant has not indicated or made clear as to what claim language is distinctly showing the argued "fundamental difference", "order of operation" and "timing of these billing operations".

In their argument, the appellant cites Col. 5, lines 43-63, as evidence that Ginzboorg does not show "a request for content is received by the proxy before content is retrieved from a content server". The scenario described in Col. 5, lines 43-63, is related to the request and setup of the content/service to be subsequently delivered to the client. While there is interaction with the content server (service provider in Ginzboorg), the content is not actually retrieved before the proxy (billing server in Ginzboorg) gets the subscriber's request. Only information <u>identifying</u> the content and the subscriber is sent from the content server so that the proxy can formulate charges based on the content requested. The content is not actually retrieved before the proxy gets the request in the description cited by the Appellant. This is further indicated in

Col. 6, lines 55-63, which states that the proxy authenticates a CDR (charging record

based on the subscribers request - see Col. 6 lines 3-10) <u>before</u> the proxy asks the

service provider to start sending the information to the customer.

Based on this evidence, it is clear that proxy in Ginzboorg receives the request

for content before content is retrieved form a content server.

Argument 3

Appellant argues on pages 11-12 of the appeal brief (under claim 1),

"   *Just as importantly, Ginzboorg fails to discern between chargeable and*
free content, as its disclosure reads. Applicant has reviewed the portions of
Ginzboorg cited for this limitation, but has yet to discover any portion of
Ginzboorg that would be germane to such a teaching. Note that it is the proxy of
Independent Claim 1 that is tasked with this determination: not some other
random element within the system. In Particular, the ability to make this
determination is significant for a number of reasons..."

Examiner's response to Argument 3:

The claim language at issue is ""*determining, by the proxy, whether or not the*

content is chargeable content, wherein the determining step includes accessing a

database that includes information that is indicative of which content is chargeable and

which content is free to end users connected to a network." (from claim 1). The

examiner first points out general citations germane to the issue:

i.   Col. 10, lines 21-26 - "METHOD OF PAYMENT: The parameter in this field is defined for CDRs of type 0, 5, 1 and 2. The methods of payment may be categorized, for example, as follows: **free, one-time charge** (one CDR, periodical or eternally triggered..." (emphasis added)

ii.   Col. 13, lines 15-24 - "The subscriber and service database can be both in the billing server and in the service provider's server... These databases can be maintained by different organizations and they do not need to be identical. For example, **free services**, do not need to be stored in the billing server databases" (emphasis added).

These two citations clearly establish that there are at least some services that are free and some that are chargeable. One of ordinary skill in the art would understand that there is some form of inherent mechanism for discerning between the two types. But since appellant has asserted that the proxy is tasked with the determination, the examiner offers further evidence.

Col. 6, lines 3-10, of Ginzboorg describes the billing server (i.e. the proxy) running a process to determine how to charge the customer based on the requested content (i.e. discerning what to charge). This includes the billing server using billing parameters stored in a database and corresponding to charging information for specific content (Col. 12, lines 42-53). Importantly, Col. 10, lines 21-29 (see i. above), describes that these parameters can indicate that the content is free or subject to a category of charge. Clearly the billing server is described by Ginzboorg as having an explicit mechanism for discerning what to charge the customer/subscriber. This mechanism for discerning includes discerning between chargeable content and free content through

the use of a database containing billing parameters which are indicative of which

content is free versus chargeable. Based on this evidence, the examiner asserts the

functionality of the billing server (i.e. the proxy) of Ginzboorg is within the scope of

"determining, by the proxy, whether or not the content is chargeable content, wherein

the determining step includes accessing a database that includes information that is

indicative of which content is chargeable and which content is free to end users

connected to a network."

Argument 4

Appellant argues on page 12 of the appeal brief (under claim 1),

"   *There are still other reasons why Independent Claim 1 is patentable over*
the proposed § 103 rejection. Independent Claim 1 discloses the use of a prepaid
amount for the subscriber terminal, which is not taught by Ginzboorg. The
Examiner relies on Davis for this limitation and explains that such a protocol is
'simple' and 'common' in content provisioning. Applicant respectfully disagrees,
as such a feature is unique: particularly so when considered at the time this case
was filed."

Examiner's response to argument 4:

The Davis reference was filed April 23, 1999. Clearly the teachings of Davis

would be relevant at the time the instant case was filed (09/21/2001 with priority to

03/23/2001). The examiner has provided in the grounds of rejection both a

teaching/suggestion/motivation rationale and a rationale based on the *KSR* decision to

support the combination of references.

Argument 5

Appellant argues on page 12 of the appeal brief (under claim 1),

" *Another fundamental difference between Ginzboorg and the pending subject matter that the Examiner should appreciate is that Ginzboorg pertains to a service and not to content delivery. Referencing again the passage of Ginzboorg provided supra, it is evident that Ginzboorg deals with types of service (e.g. Video-On-Demand) and not specific content. Evaluating Ginzboorg thoroughly confirms that its architecture is confined to services being provided to the subscriber terminal. Although this distinction appears to be minor, it is truly significant.*

For example, in the context of Ginzboorg, this would correlate to a subscriber terminal being billed for a given movie (e.g. Braveheart), as opposed to the service of Video-On-Demand. Ginzboorg clearly does not provide for such content billing..."

Examiner's response to argument 5:

From the passage appellant cites in the argument (which comes from Col. 5 lines 43-62 of Ginzboorg), it explicitly states "the customer selects the service in question (for example, **a movie**)" (emphasis added) and "the service identifier "Sid", identifying **the movie** in question"(emphasis added). Clearly the service can be a movie selected by the subscriber. Furthermore the billing is based on the selected movie. See col. 6, lines 3-10, which states,

*"After this, the billing server WD starts a process, which handles the usage of the service in question. First the billing server retrieves from the service database the parameters **corresponding to the service in question** and sends (arrow C) a certain type of charging record (CDR) to the customer terminal. The charging*

record contains the billing parameters to be used during the session in question

and the contract number." (emphasis added)

Based on the evidence above, the examiner asserts the billing of Ginzboorg includes

billing for specific content requested by the subscriber.

Argument 6

Appellants remaining arguments on pages 13-14 of the appeal brief imply that a

reason to make the combination of prior art references has not been made.

Examiner's response to argument 6:

The examiner asserts a proper reason has been provided for each combination

made as can been seen in the grounds of rejection presented above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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SALEH NAJJAR
SUPERVISORY PATENT EXAMINER

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